

Applicant: PETERSON *et al.*
Serial No: 09/708,713
Filing Date: Nov. 9, 2000
Page: 1 of 3

IN THE UNITED STATES PATENT & TRADEMARK OFFICE

IN RE PATENT APPLICATION OF:	Jay PETERSON <i>et al.</i>	ATTORNEY DOCKET NO:	032028-0311061
SERIAL NO.:	09/708,713	CONFIRMATION NO.:	8439
FILING DATE:	NOVEMBER 9, 2000	EXAMINER:	Marcus H. Tanningco
		ART UNIT:	2884
FOR:	UNMANNED INTEGRATED OPTICAL REMOTE EMISSIONS SENSOR (RES) FOR MOTOR VEHICLES		

THIRD REQUEST FOR CORRECTED FILING RECEIPT

Commissioner for Patents
P. O. Box 1450
Alexandria, VA 22313-1450

Sir:

Further to the "Request for Corrected Filing Receipt" submitted January 9, 2003, and the "Request for Corrected Filing Receipt" submitted February 25, 2005, Applicants submit this *Third* Request for Corrected Filing Receipt.

Attached is a copy of the official filing receipt from the U.S. Patent and Trademark Office in the above-referenced application for which issuance of a corrected filing receipt is respectfully requested. There are errors with respect to the following data which are inaccurate.

Error in:
Filing Date

Correct Data:
11/09/2000

(see *Decision Granting Petition under 37 CFR 1.53(b)* dated January 15, 2002)

Third Inventor's Name

Troy P. Bahan

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With regard to the filing date, attached hereto in APPENDIX A is a copy of the Decision Granting Petition Under 37 C.F.R. § 1.53(b) [**Paper No. 8**] mailed January 15, 2002 (hereinafter "Decision").

The 1st full paragraph of page 2 of the Decision recites:

A review of the official file reveals that a copy of the specification, including claims, and drawings of U.S. Patent 5,726,450, of which this application is a continuation of a reissue application, is located among the application papers received on 9 November, 2000. ***As such, the application was complete on 9 November, 2000, and entitled to a filing date of that date.***

[emphasis added].


Accordingly, issuance of a corrected filing receipt is respectfully requested.

It is believed that no fees are due in connection with the filing of this Request. In the event that it is determined that fees are due, however, the Director is hereby authorized to charge the undersigned's Deposit Account No. 033975 (Ref. No. 032028-0311061).

Date: December 2, 2008

Respectfully submitted,

By:


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UNITED STATES PATENT AND TRADEMARK OFFICE

 COMMISSIONER FOR PATENTS
 UNITED STATES PATENT AND TRADEMARK OFFICE
 WASHINGTON, D.C. 20231
www.uspto.gov

APPLICATION NUMBER	FILING DATE	GRP ART UNIT	FIL FEE REC'D	ATTY. DOCKET NO	DRAWINGS	TOT CLAIMS	IND CLAIMS
09/708,713	10/11/2001 11/09/2000	2878	1634	47382.000111	7	41	8

 James G Gatto Esq
 Hunton & Williams
 1900 K Street NW
 Washington, DC 20006-1109

CONFIRMATION NO. 8439

FILING RECEIPT



OC000000008791908

Date Mailed: 09/16/2002

Receipt is acknowledged of this nonprovisional Patent Application. It will be considered in its order and you will be notified as to the results of the examination. Be sure to provide the U.S. APPLICATION NUMBER, FILING DATE, NAME OF APPLICANT, and TITLE OF INVENTION when inquiring about this application. Fees transmitted by check or draft are subject to collection. Please verify the accuracy of the data presented on this receipt. **If an error is noted on this Filing Receipt, please write to the Office of Initial Patent Examination's Filing Receipt Corrections, facsimile number 703-746-9195. Please provide a copy of this Filing Receipt with the changes noted thereon. If you received a "Notice to File Missing Parts" for this application, please submit any corrections to this Filing Receipt with your reply to the Notice. When the USPTO processes the reply to the Notice, the USPTO will generate another Filing Receipt incorporating the requested corrections (if appropriate).**

Applicant(s)

 Jay Peterson, Montecito, CA;
 David R. Nelson, Santa Barbara, CA;
~~Troy A. Bahan~~, Santa Barbara, CA; Troy P. Bahan
 George C. Polchin, Santa Barbara, CA;
 Michael D. Jack, Goleta, CA;

Domestic Priority data as claimed by applicant

 THIS APPLICATION IS A CON OF 09/521,858 03/09/2000
 WHICH IS A REI OF 08/739,487 10/26/1996 PAT 5,726,450

Foreign Applications

If Required, Foreign Filing License Granted 09/13/2002

Projected Publication Date: Not Applicable

Non-Publication Request: No

Early Publication Request: No

Title

Unmanned integrated optical remote emissions sensor (RES) for motor vehicles

Preliminary Class

250

**LICENSE FOR FOREIGN FILING UNDER
Title 35, United States Code, Section 184
Title 37, Code of Federal Regulations, 5.11 & 5.15**

GRANTED

The applicant has been granted a license under 35 U.S.C. 184, if the phrase "IF REQUIRED, FOREIGN FILING LICENSE GRANTED" followed by a date appears on this form. Such licenses are issued in all applications where the conditions for issuance of a license have been met, regardless of whether or not a license may be required as set forth in 37 CFR 5.15. The scope and limitations of this license are set forth in 37 CFR 5.15(a) unless an earlier license has been issued under 37 CFR 5.15(b). The license is subject to revocation upon written notification. The date indicated is the effective date of the license, unless an earlier license of similar scope has been granted under 37 CFR 5.13 or 5.14.

This license is to be retained by the licensee and may be used at any time on or after the effective date thereof unless it is revoked. This license is automatically transferred to any related applications(s) filed under 37 CFR 1.53(d). This license is not retroactive.

The grant of a license does not in any way lessen the responsibility of a licensee for the security of the subject matter as imposed by any Government contract or the provisions of existing laws relating to espionage and the national security or the export of technical data. Licensees should apprise themselves of current regulations especially with respect to certain countries, of other agencies, particularly the Office of Defense Trade Controls, Department of State (with respect to Arms, Munitions and Implements of War (22 CFR 121-128)); the Office of Export Administration, Department of Commerce (15 CFR 370.10 (j)); the Office of Foreign Assets Control, Department of Treasury (31 CFR Parts 500+) and the Department of Energy.

NOT GRANTED

No license under 35 U.S.C. 184 has been granted at this time, if the phrase "IF REQUIRED, FOREIGN FILING LICENSE GRANTED" DOES NOT appear on this form. Applicant may still petition for a license under 37 CFR 5.12, if a license is desired before the expiration of 6 months from the filing date of the application. If 6 months has lapsed from the filing date of this application and the licensee has not received any indication of a secrecy order under 35 U.S.C. 181, the licensee may foreign file the application pursuant to 37 CFR 5.15(b).

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APPENDIX A

Copy of the Decision Granting Petition Under 37 C.F.R. § 1.53(b) [**Paper No. 8**],
mailed January 15, 2002



UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
Washington, D.C. 20231
www.uspto.gov
OW 01-02

Paper No. 8

JAMES G. GATTO, ESQ
HUNTON & WILLIAMS
1900 K STREET, NW
WASHINGTON, DC 20006-1109

COPY MAILED

JAN 15 2002

OFFICE OF PETITIONS

In re Application of	: DECISION GRANTING PETITION
Peterson et al.	: UNDER 37 CFR 1.53(b).
Application No. 09/708,713	: AND REFUSING STATUS
Filed: 9 November, 2000	: UNDER 37 CFR 1.47(b)
Atty Dckt No. 47382.000111	:

This is in response to the petition filed on 11 October, 2001, requesting that the above-identified application be accorded a filing date of 9 November, 2000. This is also a decision on the petition under 37 CFR 1.47(b) filed on 13 November, 2001,

The petition under 37 CFR 1.53(b) is GRANTED.

The petition under 37 CFR 1.47(b) is DISMISSED.

Rule 47 applicant is given TWO MONTHS from the mailing date of this decision to reply, correcting the below-noted deficiencies. Any reply should be entitled "Request for Reconsideration of Petition Under 37 CFR 1.47(b)," and should only address the deficiencies noted below, except that the reply may include an oath or declaration executed by the non-signing inventor.

FAILURE TO RESPOND WILL RESULT IN ABANDONMENT OF THE APPLICATION.

Extensions of time may be obtained in accordance with 37 CFR 1.136(a).

PETITION UNDER 37 CFR 1.53(b)

The application was deposited on 9 November, 2000. On 10 April, 2001, Initial Patent Examination Division mailed a Notice of Incomplete Nonprovisional Application, stating that the application had not been accorded a filing date because the

specification was missing.

A review of the official file reveals that a copy of the specification, including claims, and drawings of U.S. Patent 5,726,450, of which this application is a continuation of a reissue application, is located among the application papers received on 9 November, 2000. As such, the application was complete on 9 November, 2000, and entitled to a filing date of that date.

PETITION UNDER 37 CFR 1.47(b)

In response to the Notice of Incomplete Application filed on 10 April, 2001, which required a signed oath or declaration, petitioners filed on 13 November, 2001,¹ the present petition, accompanied by a declaration naming Jay Peterson, David R. Nelson, Troy P. Bahan, George C. Polchin, and Michael D. Jack as joint inventors and signed by petitioners' registered patent attorney, Christopher Cuneo, on behalf of Environmental Systems Products Holdings, Inc., parent corporation of assignee Envirotest Systems Corporation, and a petition for a five (5) month extension of the time to reply to the Notice of Incomplete Application.

Petitioners assert that a copy of reissue Application No. 09/521,858, a preliminary amendment, and the declaration for the present application was sent to each of the inventors. Petitioners assert that joint inventors Peterson, Nelson, Polchin, and Jack failed to sign and return the declaration. Petitioners further assert that the papers sent to joint inventor Bahan were returned as undeliverable. Petitioners have also shown that the inventors assigned their interest in the invention to HE Holdings, Inc. DBA Hughest Electronics, which assigned its interest to Hughes Aircraft Company, which in turn assigned its interest to Envirotest Systems Corporation.

A grantable petition under 37 CFR 1.47(b) requires:

(1) proof that the non-signing inventor cannot be reached or refuses to sign the oath or declaration after having been presented with the application papers (specification, claims and drawings);

(2) an acceptable oath or declaration in compliance with 35

¹ 10 November, 2001, fell on a Saturday, and 12 November, 2001, fell on a Federal holiday, so the response filed on 13 November, 2001, was timely filed. See 37 CFR 1.7(a).

U.S.C. §§ 115 and 116;

- (3) the petition fee;
- (4) a statement of the last known address of the non-signing inventor;
- (5) proof of proprietary interest, and
- (6) proof of irreparable damage.

The petition lacks item (1).

In regards to item (1), petitioner has not provided sufficient proof that a copy of the application as filed was sent or given to the non-signing inventor for review.²² Rather, the declaration of petitioners' registered patent counsel, Christopher Cuneo, is that a copy of the prior application, No. 09/521,858, was sent to the inventors and that subsequently an amendment and the declaration for the present application was sent to each of the inventors. Before a *bona fide* refusal to sign can be alleged, petitioners must show that a copy of the application as filed (specification, including claims, drawings, if any, and the declaration) must be sent or given to each joint inventor.

Petitioners may show proof that a copy of the application was sent or given to the non-signing inventors by providing a copy of the cover letter transmitting the application papers to the non-signing inventors or details given in an affidavit or declaration of facts by a person having first hand knowledge of the details.

Likewise, petitioners must show proof that the non-signing inventor refuses to sign the declaration after being sent or given a copy of the application papers. If there is a written refusal, petitioners must provide a copy of that written refusal with any renewed petition. If the refusal is made orally, then the person to whom the refusal was made must provide details of the refusal in an affidavit or a declaration of facts.

Additionally, a brief Internet search shows that joint inventor Bahan, whom petitioners assert could not be found, may be living in Goleta, CA. Petitioners should investigate whether a more recent address is available for joint inventor Bahan. If a current address is found, a copy of the application papers should be sent to joint inventor Bahan at the last known address. If continued attempts to send or give a copy of the application to, and obtain an executed declaration from, Bahan fail, then

²²MPEP 409.03(d).

petitioner will have shown a refusal to sign the declaration based on conduct. The proof of pertinent events should be made by an affidavit or declaration of facts by a person with first-hand knowledge of the details.

Although petitioners submitted a check for \$2,220.00 with the petition filed on 13 November, 2001, that check was returned as unpaid on 19 November, 2001. As a result, counsel's deposit account, No. 50-0311, will be charged \$1,960.00 for the five (5) month extension of time, \$130.00 for the petition under 37 CFR 1.47(b) fee, \$130.00 for the late filing surcharge, and the \$50.00 processing fee due for a returned check. The \$130.00 fee for the petition under 37 CFR 1.53 filed on 11 October, 2001, will be refunded to counsel's deposit account.

It is additionally noted that although this application is a continuation of a reissue application, it was not processed with a reissue application folder. The application will be returned to OIPE for reprocessing in a reissue application folder after a grantable petition under 37 CFR 1.47(a) is filed.

Further correspondence with respect to this matter should be addressed as follows:

By mail: Assistant Commissioner for Patents
Box DAC
Washington, D.C. 20231

By FAX: (703) 308-6916
Attn: Office of Petitions

By hand: Crystal Plaza Four, Suite 3C23
2201 S. Clark Place
Arlington, VA

Telephone inquiries related to this decision should be directed to Douglas I. Wood at (703)308-6918.



Beverly M. Flanagan
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Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy